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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,656	08/17/2001	Edgar Michael Fitzsimons	4301-4000	4563
27123	7590	07/14/2005	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			LUDWIG, MATTHEW J	
			ART UNIT	PAPER NUMBER
			2178	
DATE MAILED: 07/14/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/932,656

Applicant(s)

FITZSIMONS ET AL.

Examiner

Matthew J. Ludwig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-104 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-104 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/21/02
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is in response to the response to Election/Restriction received 4/29/05.
2. Claims 1-104 are pending in the application. Claims 1, 6, 11, 16, 21, 28, 35, 42, 49, 56, 63, 70, 77, 84, 91, and 98, are independent claims.
3. In response to applicant's response to the Election/Restriction, the Examiner has withdrawn the Election/Restriction pursuant to applicant's arguments.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

In reference to independent claim 21, the claim recites the phrase 'potential page elements'.

There is insufficient antecedent basis for this limitation within the claim. The examiner is unclear as to what defines a 'potential' page element. The word potential, by itself, is vague and appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alam et al., USPN 6,336,124 filed (7/7/1999).**

**In reference to independent claim 21, Alam teaches:**

The determination whether the input data is in a format supported as an input format (compare to “*identifying a source of data*”). See column 5, lines 20-25.

The process may first recognize the input format, such as WORD, of the input document (compare to “*identifying the source device format type*”). See column 7, lines 25-30.

The one or more output formats may be specified by the user, all or one or more output formats supported by method, and /or determined based upon the application or device to which the converted data output is outputted (compare to “*identifying a target device*”). See column 5, lines 37-45.

The process may first recognize the input format, such as WORD, of the input document. If the tags of the input document are recognizable, then dictionary tags for that input format or type may be utilized (compare to “*instantiating a source device format document based on the source device format type*”). See column 7, lines 25-35.

The data stored in the intermediate format is converted to one or more of the supported output formats. The output formats maybe one or more versions of HTML, XML, CSS, sand separate pages, PDF, TIF, and other key formats (compare to “*instantiating a target device format document based on the target device format type*”). See column 12, lines 53-60.

If the tags of the input document are recognizable, then dictionary tags for that input format or type may be utilized to translate the located tags into the intermediate format (compare to “*converting the source data for use in the source device format document*”). See column 7,

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lines 26-31. The elements found within the source document as taught by Alam would have provided a proficient and similar example of a proposed element parsed within a document.

Tags contain information about the specific portion such as identification as a heading, a table, a paragraph, or a list, font etc. (compare to “*generating source page elements with identifying source tags within the source device format document*”). See column 7, lines 32-47.

The tags may be utilized to facilitate execution of subsequent steps. If results of such subsequent steps conflict with the information contain in the tags, the results from the steps preferably supersede or replace the information in the tags (compare to “*populating source page elements with associated source data*”). See column 7, lines 35-48.

Output format blocks are generated for each block of the intermediate format. Output format blocks are created such that the coordinates of the output format blocks in the output format style sheet correspond to coordinates of the intermediate format blocks (compare to “*identifying page elements in the target device format type and generating target page elements with identifying target tags corresponding to source page elements*”). See column 13, lines 1-29.

The fonts of each intermediate format block is mapped to a font in the output format font such that each block in the intermediate format fits in the corresponding output format text blocks. After completion of all iterations, an output RTF or HTML with style sheets format document is outputted (compare to “*transforming attributes associated with the generated target page elements according to attributes associated with the target device format document*”). See column 13, lines 5-34.

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Blocks in the intermediate format may be processed individually such that process is executed once for each intermediate format block, in multiple groups such that the process is executed once for each group of intermediate format blocks, or all at once such that process is executed once for all the intermediate format blocks (compare to “*identifying transformation parameters for transforming target page elements based on the differences between the source device format type and the target device format type*”). See column 13, lines 10-54. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized the multiple ways to process format blocks as taught by Alam as a way to provide parameters for transforming attributes because it gives the system a means of parsing through text using different sets of rules, which provide a similar employment as parameters, that would allow for a direct conversion between two distinct formats.

**In reference to dependent claim 22**, Alam teaches:

The elements found within the source document as taught by Alam would have provided a proficient and similar example of a proposed element parsed within a document.

Tags generally contain information about the specific portion such as identification as a heading, a table, a paragraph, or a list, font etc. (compare to “*generating source page elements with identifying source tags within the source device format document*”). See column 7, lines 32-47.

**In reference to dependent claim 23**, Alam teaches:

Tags generally contain information about the specific portion such as identification as a heading, a table, a paragraph, list, and/or other information such as alignment, font, etc. See column 7, lines 33-40.

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**In reference to dependent claim 24, Alam teaches:**

Locating and storing tags in the input format document. See column 7, lines 14-16.

**In reference to dependent claim 25, Alam teaches:**

The information stored in the intermediate format may include one or more blocks. Each block may be a paragraph, an element in a table, all or a portion of the table, depending upon the spacing of the elements of the table, or an image. See column 13, lines 5-15.

**In reference to dependent claim 26, Alam teaches:**

The information stored in the intermediate format may include one or more blocks. Each block may be a paragraph, an element in a table, all or a portion of the table, depending upon the spacing of the elements of the table, or an image. See column 13, lines 5-15.

**In reference to dependent claim 27, Alam teaches:**

The fonts of each intermediate format block is mapped to a font in the output format font such that each block in the intermediate format fits in the corresponding output format text blocks. After completion of all iterations, an output RTF or HTML with style sheets format document is outputted.

**In reference to claims 1-5, 28-34, and 35-41, the method claims reflect similar instructions used for performing the format transforming methods as claimed in 21-27. Therefore, in further view of the following, the claims are rejected under similar rationale.**

**In reference to claims 6-10, 42-48, 49-55, and 56-62, the system claims reflect similar instructions used for performing the format transforming methods as claimed in 21-27.**

**Therefore, in further view of the following, the claims are rejected under similar rationale.**

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In reference to claim 11-20, 63-104, the claims reflect the computer program and the apparatus used for performing the format transforming methods as claimed in 21-27. Therefore, in further view of the following set of rejections, the claims have been rejected under similar rationale.

*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Guck                      USPN 5,911,776                      filed (12/18/1996)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Ludwig whose telephone number is 571-272-4127.

The examiner can normally be reached on 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML

*William L. Bashore*  
WILLIAM BASHORE  
PRIMARY EXAMINER  
7/11/2005